



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AUG 12 2002

In re

:
:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 17, 18, 30, 35, 47 and 49 of the morning session and questions 4, 6, 12, 27, 33, 38, 43 and 48 of the afternoon session of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sessions of the Registration Examination. Petitioner scored 67.

On February 1, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers. The directions to the morning and afternoon sessions state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications

for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been granted one additional point on the Examination for his answer (C) to afternoon question 12. No credit has been awarded for morning question 17, 18, 30, 35, 47, or 49, and no credit has been awarded for afternoon question 4, 6, 27, 33, 38, 43, or 48. Petitioner's arguments for these questions are addressed individually below.

Morning question 17 reads as follows:

The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

- (A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.

- (B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.
- (D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
- (E) None of the above.

The model answer is selection (C).

17. ANSWER: (C) is the correct answer. 35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted's application. (D) is incorrect because the Japanese patent application issued after the date of Ted's application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (E) is the most correct answer because all answers should be recognized as correct, and because in answer (E), the preamble must be given weight. Petitioner has provided no reasons why answer (A) should be accepted as correct. Regarding answer (B), petitioner indicates that it is not 102(b) prior art because the issue date is less than a year, but it could be 102(e) prior art depending upon when it was filed. See MPEP § 715 under the heading "SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE." A reference that only qualifies as prior art under 35 U.S.C. 102(a) or (e) is not a "statutory bar." Regarding

answer (D), petitioner argues that the answer “could and is highly probably a 102(a) bar.” Again, see MPEP § 715. A reference that only qualifies as prior art under 35 U.S.C. 102(a) or (e) is not a “statutory bar.” Regarding answer (E), petitioner argues that “The preamble is not given the effect of a limitation unless it breaths life and meaning into the claim.” As provided in MPEP 2111.03, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). Accordingly, it is at least *possible* that the patent to Ned in answer (C) is a statutory bar under 35 U.S.C. § 102(b). Answer (C) is the most correct answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 18 reads as follows:

18. Which of the following is in accord with proper USPTO practice and procedure?
- (A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112
 - (B) A claim to a process consisting solely of mathematical operations, *i.e.*, converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.
 - (C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.

- (D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are statutory natural phenomena.
- (E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

The model answer is selection (B).

18. ANSWER: The most correct answer is (B). MPEP § 2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), “If the ‘acts’ of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.” (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O’Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter), and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff’d per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

Petitioner’s arguments have been fully considered but are not persuasive.

Petitioner has argued that the quote the PTO used in the model answer does not appear in the cited section. The quoted section appears in MPEP § 2106, paragraph IV.B.1. See also *In re Schrader*, 22 F.3d 290 at 294-95, 30 USPQ2d 1445 at 1458-59 (Fed. Cir. 1994). If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a process consisting solely of mathematical operations,

i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process. Petitioner argues that answer (E) is the most correct answer. However, as provided in MPEP § 2106, paragraph IV.B.2.(a), A composition of matter is “a composition of two or more substances....” See also *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff’d per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958))

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 30 reads as follows:

30. Which of the following is most likely to be considered in a proper obviousness determination?

- (A) Evidence demonstrating the manner in which the invention was made.
- (B) Evidence that a combination of prior art teachings, although technically compatible, would not be made by businessmen for economic reasons.
- (C) Evidence demonstrating the level of ordinary skill in the art.
- (D) Evidence that one of ordinary skill in the art, after reading Kat’s application, would readily be able to make and use Kat’s invention without undue experimentation.
- (E) Evidence that the distance finder described in the July 2000 golf magazine has enjoyed great commercial success.

The model answer is selection (C).

30. ANSWER: The most correct answer is (C). The level of ordinary skill in the art is one of the factors that must be considered in any obviousness determination. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). (A) is not the best answer because 35 U.S.C. § 103 specifically states that patentability shall not be negated by the manner in which the invention was made. (B) is not the best answer because economic unfeasibility is not a basis for a determination of nonobviousness. See MPEP § 2145 VII. (D) is directed to the

issue of enablement, not obviousness. (E) is wrong because the commercial success of the prior art distance finder is not relevant (although commercial success of Kat's invention would be relevant).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that his answer (D) is the most correct answer. As stated in the model answer, answer (D) is directed to enablement, not obviousness. Answer (C) is the most correct answer. As provided in MPEP § 2141, resolving the level of ordinary skill in the pertinent art is the third of the four factual inquiries set forth by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 35 reads as follows:

35. During their period of courtship, Amy and Pierre invented and actually reduced to practice an improved frying pan, wherein the sides and integral handle are formed from a metal having a low coefficient of conductivity, and a base providing the cooking surface formed from a metal having a high coefficient of conductivity. While the basic concept was old in the art, Amy's concept was to sandwich a layer of aluminum between layers of copper, while Pierre's concept was to sandwich a layer of copper between layers of aluminum. Accordingly, acting as *pro se* joint inventors, they filed a nonprovisional patent application in the USPTO on January 10, 2001, along with a proper nonpublication request. The application disclosed both Amy's and Pierre's concepts in the specification, and contained three independent claims: claim 1 was generic to the two concepts; claim 2 was directed to Amy's concept, and claim 3 was directed to Pierre's concept. Thereafter, Amy and Pierre had a "falling out" and Pierre returned to his home in France where he filed a corresponding patent application in the French Patent Office on January 31, 2001. Pierre was completely unaware of any obligation to inform the USPTO of the French application. Amy first learned of Pierre's application in the French Patent Office on October 10, 2001. Once Amy learns of the French application, which of the following

actions should she take which accords with proper USPTO practice and procedure and which is in her best interest?

- (A) Immediately notify the USPTO of the filing of the corresponding application in the French Patent Office. (B) Promptly submit a request to the USPTO under Amy's signature to rescind the nonpublication request.
- (C) File an amendment under Amy's signature deleting claim 3 and requesting that Pierre's name be deleted as an inventor on the ground that he is not an inventor of the invention claimed.
- (D) Promptly file a document, jointly signed with Pierre, giving notice to the USPTO of the filing of the corresponding application in the French Patent Office and showing that any delay in giving the notice was unintentional.
- (E) File an application for a reissue patent that is accompanied by an amendment paper with proper markings deleting Pierre's concept from the specification and a statement canceling claims 1 and 3.

The model answer is selection (D).

35. ANSWER: (D) is correct because 35 U.S.C. § 122(b)(2)(B)(iii) indicates that such action may avoid abandonment of the application. (A) is wrong because the action is being taken more than 45 days after filing of the corresponding application in the French Patent Office and thus will not avoid abandonment of the application. 35 U.S.C. § 122(b)(2)(B)(iii). (B) is wrong because 37 CFR 1.213(a)(4) requires that the request be signed in compliance with 37 CFR 1.33(b)(4), which requires that all applicants sign. (C) is wrong because such action will not avoid abandonment of the application pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). (E) is wrong because Amy's application has not issued as a patent, and reissue relates only to applications that have issued as patents.

Petitioner's arguments have been fully considered but are not persuasive. Petitioner has argued that answer (A) was the best of a bad set of choices. However, answer (A) does not make any provision for "showing that any delay in giving the notice was unintentional" as provided in answer (D). In addition, merely notifying the USPTO after the forty-five day time period will not change the fact that the application is abandoned. Therefore, following the action in answer (A) will not alter the status of Amy's application. In addition, by following the action in answer (A), Amy may not be able to file a petition and state that the delay was "unintentional." A requirement for such a

petition is that the entire delay from the date the notification was due under 35 U.S.C. § 122(b)(2)(B)(iii) to the date a grantable petition was filed was unintentional. See 37 CFR 1.137(b) and (f). Therefore, if Amy intentionally delays filing the petition, as suggested by petitioner, she might not be able to properly file the petition at a later time. Answer (D) is the only answer that will result in the revival of Amy's application. Accordingly, answer (D) is the most correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 47 reads as follows:

47. Registered practitioner Rick drafted a patent application for inventor Sam. The application was filed in the USPTO on May 15, 2000, with a power of attorney appointing Rick. On March 15, 2001, Sam filed a revocation of the power of attorney to Rick, and a new power of attorney appointing registered practitioner Dave. In a non-final Office action dated September 12, 2001, the examiner included a requirement for information, requiring Dave to submit a copy of any non-patent literature, published application, or patent that was used to draft the application. Which of the following, if timely submitted by Dave in reply to the requirement for information, will be accepted as a complete reply to the requirement for information?

- (A) A statement by Dave that the information required to be submitted is unknown and is not readily available to Dave.
- (B) A statement by Dave that the requirement for information is improper because it was included in a non-final Office action.
- (C) A statement by Dave that the requirement for information is improper because Dave is not an individual identified under 37 CFR 1.56(c).
- (D) A statement by Dave that the requirement for information is improper because information used to draft a patent application may not be required unless the examiner identifies the existence of a relevant database known by Sam that could be searched for a particular aspect of the invention.
- (E) None of the above.

The model answer is selection (A).

47. ANSWER: (A) is the correct answer. 37 CFR 1.105(a)(3). 37 CFR 1.105, effective date November 7, 2000, "Changes To Implement the Patent Business Goals; Final Rule," September 8, 2000, 65 FR 54604, 54634; MPEP § 704.12(b) (pg. 700-10) (8th Ed.). (B) is incorrect because the requirement for information may be included in an Office action, or sent separately. 37 CFR 1.105(b). (C) is incorrect because 37 CFR 1.56(c) includes each attorney or agent who prepares or prosecutes the application. 37 CFR 1.56(c)(2). (D) is incorrect because information used to draft a patent application may be required and there is no support for (D) in 37 CFR 1.105. (E) is incorrect because (A) is correct.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (A) is incorrect and that answer (E) is therefore the most correct answer. Petitioner argues that the duty under Rule 105 is properly directed at all qualifying people in the chain under Rule 56, and that Dave's reply should be required to indicate that Dave had checked out the whereabouts of the information with other people qualifying under Rule 56. As provided in MPEP § 704.12(b), "A reply stating that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will generally be sufficient unless, for example, it is clear the applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible." Accordingly, answer (A) is the most correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 49 reads as follows:

49. Joe files a nonprovisional patent application containing claims 1 through 10 in the USPTO and properly receives a filing date of December 6, 2000. The first Filing Receipt including a confirmation number for the application was mailed on December 20, 2000. On January 30, 2001, the examiner mails Joe a NOTICE indicating that a nucleotide sequence listing in accordance with 37 CFR§ 1.821-1.825 is required. On February 27, 2001, Joe files the required sequence listing as well as a preliminary amendment adding claims 11 through 13 to the application, along with a copy of the application as amended in compliance with the Office electronic filing system requirements. Assuming the Office has not started the publication process at such time and that Joe's application is subsequently published pursuant to 35 U.S.C. § 122(b), which of the following statements accords with proper USPTO practice and procedure?

- (A) The published application will contain claims 1 through 10 only because the preliminary amendment adding claims 11 through 13 was not submitted in reply to the NOTICE.
- (B) The published application will contain claims 1 through 13 because a copy of the application as amended in compliance with the Office electronic filing system requirements was filed.
- (C) The published application will contain claims 1 through 10 only because the copy of the application as amended in compliance with the Office electronic filing system requirements was not filed within one month of the actual filing date of the application.
- (D) The published application may contain claims 1 through 13 because the Office may use an untimely filed copy of the application as amended in compliance with the Office electronic filing system requirements where the Office has not started the publication process.
- (E) The published application will contain claims 1 through 10 only because publication is based solely on the application papers deposited on the filing date of the application.

The model answer is selection (B) and (D).

49. ANSWER: (B) and (D) are correct and (A), (C), and (E) are wrong. 37 CFR 1.215 (“(c) At applicant’s option, the patent application publication will be based upon the copy of the application...as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later. (d)...If...the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.”). The Office in a notice (“Assignment of Confirmation Number and Time Period for Filing a Copy of an

Application by EFS for Eighteen-Month Publication Purposes”) in the Official Gazette on December 26, 2000, (1241 O.G. 97) advised that an electronic filing system (EFS) copy of an application will be used in creating the patent application publication even if it is submitted outside the period set forth in 37 CFR 1.215(c), provided that it is submitted within one month of the mailing date of the first Filing Receipt including a confirmation number for the application. While the published application is based on the application as originally filed, if applicant submits an amended version of the application via EFS within the time period set forth in section 1.215(c), the amended version of the application will be used for the publication. Based on the facts given in the question, the amended version of the application was timely filed within the fourteen-month window because the earliest filing date for which a benefit is sought is the filing date (December 6, 2000) of the application. Answers (A), (C) and (E) are all wrong because each answer states that the published application will only include claims 1-10, however, the publication will include claims 1-13 filed with the EFS submission.

Petitioner has argued that answer (E) is the most correct answer because model answer (D) is not as good an answer as answer (E). Petitioner argues that an amended application may be published ONLY if the applicant desires it to be, and that nothing in the fact pattern gives any evidence that this is the case. Petitioner’s arguments have been fully considered but are not persuasive. In the question, Joe did chose to have the amended application published through his act of filing the amended application via EFS. If applicant submits an amended version of the application via EFS within the time period set forth in section 1.215(c), the amended version of the application will be used for the publication. See 1241 O.G. 97 (Dec. 26, 2000). Currently, pre-grant publication is the only reason to file an amended application via EFS. Since Joe did timely exercise his option under 37 CFR 1.215(c), answer (E) is not a correct answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 4 reads as follows:

4. In 1996, Sydney, while vacationing at the North Pole, invents a new method of ice fishing using a solar powered fishhook with a transmission device for indicating the presence of a fish. For 5 years, Sydney practiced his invention exclusively at the North Pole, outside of the United States, its possessions, or its territories or any WTO or NAFTA country. He showed his invention to only one person, his friend Charlie, while Charlie was visiting him at the North Pole in June 2001. Charlie spoke to no one in the United States about the idea and crafted a near duplicate and began to publicly use it upon his return to Wisconsin in September 2001. On October 18, 2001, Sydney telephones you and complains to you that Charlie, the only person who has ever seen Sydney's device, has begun using his device. In the October 18, 2001 phone conversation, Sydney asks you for advice as to the filing of a patent application. Which of the following is the best advice for Sydney?

- A) The witnessing of the fishhook by Charlie in June 2001 constitutes knowledge of the invention, and claims directed to Sydney's invention could be properly rejected under 35 U.S.C. §102(a).
- B) Use of the device in Wisconsin constitutes public use and since Sydney cannot establish prior invention through activities at the North Pole, he is precluded from antedating the date of the first public use in the United States.
- C) Since Sydney invented the fishing device in 1996, he is the prior inventor and can overcome the first date of public use by Charlie by filing a 37 CFR 1.131 affidavit or declaration.
- D) Since Charlie first used the fishing device in the United States, Charlie may file a patent application.
- E) Since Charlie's public use in Wisconsin was not authorized, Sydney may still file a patent application on the fishing device.

The model answer is selection (B).

4. ANSWER: (B). Sydney is precluded from filing for a patent because of Charlie's recent public use in Wisconsin. A declaration or affidavit under 37 CFR 1.131 is not permissible since the use at the North Pole did not occur in a NAFTA or WTO country. Answer (A) is not correct as the knowledge did not occur in the United States and was not public knowledge. Answer (C) is not correct because of the reasoning stated in (B). Answer (D) is not correct since Charlie was not the inventor. Answer (E) is not correct since public use in the United States by a third party may establish a date for prior art purposes. 35 U.S.C. § 102(a).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (D) is the most correct answer. Answer (D) provides

that “Since Charlie first used the fishing device in the United States, Charlie may file a patent application.” The answer is incorrect. 37 CFR 1.41(a) provides that a patent is applied for “in the name or names of the actual inventor or inventors.” As set forth in MPEP 2137.01, in order to be an inventor, an individual must contribute to the conception of the invention. In Afternoon Question 4, Charlie did not contribute to the conception of the invention. Accordingly, he was not an inventor, and it would be improper to name Charlie as the inventor rather than Sydney. Answer (B) is the best answer because as provided in 37 CFR 1.131(a), “Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country.”

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client’s patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting _____

- (A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.
- (B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.
- (C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, *i.e.*, that the system “could be constructed.”
- (D) opinion evidence directed to the ultimate legal issue of enablement.

(E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

The model answer is selection (A).

6. ANSWER: The most correct answer is (A). MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)). Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a prima facie case of nonenablement. See *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02 (Arguments of Counsel), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *Hirschfield v. Banner, Commissioner of Patents and Trademarks*, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, (Referencing Prior Art Documents), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (A) is an incorrect answer because it is incomplete.

Petitioner argues that "detail should be given to the level of skill in the art." Answer (A) includes factual evidence directed to the "level of knowledge required for the practice of the invention." Accordingly, answer (A) is not incomplete. Answer (C) is a less correct answer. The affidavit in answer (C) would not be probative because it is made by someone who is not a routineer in the art, and because it recites conclusions or opinions with few facts to support or buttress the conclusions. See MPEP § 2106.02.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 27 reads as follows:

27. Mary, a legally competent adult inventor, filed provisional application A on January 3, 2000, a nonprovisional application B one year later on January 3, 2001, and nonprovisional application C on February 28, 2001. Nonprovisional application B was abandoned when nonprovisional application C was filed. The provisional application and both nonprovisional patent applications were in Mary's name only, but a declaration has not yet been filed. Mary is living on a remote island in the middle of the Arctic Ocean where the only communication is in the summer months. Sam, the father of Mary, has been authorized by Mary to sign Mary's name to the § 1.63 declaration and also Sam's name. Sam, unbeknownst to Mary, also wants access to all three application files at the USPTO before he files the declaration to make certain Mary has properly described her invention. Sam acknowledges he is not an inventor but insists he must sign as an inventor so that he may act on behalf of Mary. Which of the following is not in accordance with proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Sam may not add his name as an inventor since a patent is applied for only in the name or names of the actual inventor or inventors.
- (B) Since no declaration was filed during the pendency of application B, Sam may not see the Application papers for application B since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (C) Sam is not entitled to access to the provisional application A since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (D) Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor.
- (E) Sam may sign Mary's name to the declaration since he was authorized by Mary to do so.

The model answer is selection (E).

27. ANSWER: (E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word "made" implies signing or executing and is derived from §1.64. See 37 CFR 1.41(c). (A) contains the elements of 37 CFR 1.41(a). As to (B) the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribe by 37 CFR 1.63, except as provided for in 37 CFR§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the applications papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(I), supplying or changing the name or names of the inventor or inventors. Mary has not authorized Sam to inspect application B. Statement (C) is in accordance with 37 CFR 1.41(a)(2). Mary has

not given Sam power to inspect the provisional application. (D) is in accordance with 37 CFR 1.41(a)(3). Mary did not authorized Sam to inspect the provisional application.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner chose answer (D), but has provided no reasons why answer (D) is a more correct answer than model answer (B). Answer (D) indicates that Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor. Afternoon question 27 asks for the answer that is not in accordance with proper USPTO procedure. Answer (D) is in accordance with proper USPTO procedure, and answer (D) is therefore not the best answer to Afternoon question 27. Sam was not named as an inventor under 37 CFR 1.41(a)(3), and no facts have been stated which would permit him to have access to the application under 37 CFR 1.11 or under 37 CFR 1.14. Mary's authorization for him to sign her name and Sam's name to the § 1.63 declaration in application C is not a power to inspect application B under 37 CFR 1.14(d). In contrast to answer (D), answer (E) is not in accordance with proper USPTO procedure, and therefore answer (E) is a correct answer to Afternoon question 27. Petitioner has argued that state laws governing powers of attorney would permit Mary to appoint her father to be her agent with full power of attorney. Petitioner's argument is not in accord with the relevant statute and case law. 35 U.S.C. § 118 and 37 CFR 1.47(b) govern when another person may sign the declaration on behalf of and as an agent for the inventor. As provided in *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973), in order for another person to sign the declaration on behalf of and as an agent for the inventor, the person filing the application must have such a proprietary interest as to be

able to participate in the grant of a patent issued on the basis of the application.

Examples of such a person are exclusive licensees or trustees in bankruptcy.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

Claim 1. An apparatus for converting solar energy into electrical energy comprising:

- (i) a metallic parabolic reflector;
- (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
- (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

- (A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.

- (B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.
- (C) Traverse the rejection arguing that the examiner does not create a *prima facie* case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.
- (D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.
- (E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

33. ANSWER: (D) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a *prima facie* case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner chose answer (A) to Afternoon question 33. Petitioner provided no arguments in support of why answer (A) should be accepted as the most correct answer to this question. 37 CFR 10.7(c) requires that "[a]ny applicant requesting regarding shall particularly point out errors which the applicant believed occurred in the grading of his or her examination." The petitioner has failed to particularly point out any errors that occurred in the grading of his examination for afternoon question 33. Therefore, the requirements of 37 CFR 10.7(c) have not been met.

Accordingly, no error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 38 reads as follows:

38. Your clients, Able and Baker, filed a patent application. In accordance with proper USPTO practice and procedure, in which of the following instances, absent additional facts, is the reference or event either prior art or an act that may not be properly applied to reject claims in your client's application?

(A) The patent application was filed on Tuesday, June 26, 2001 in the USPTO. The reference is an article in a trade magazine published on November 10, 2000. Able, Baker and McGeiver are the authors of the article. The article fully discloses the claimed invention and how to make and use it.

(B) The patent application was filed on Monday, June 25, 2001 in the USPTO. Able and Baker placed the invention on sale in the United States on Monday, June 26, 2000. The public came into possession and understands the invention the day it is placed on sale. Your clients have disclosed this information when they filed the application.

(C) The patent application was filed on Monday, June 25, 2001, in the USPTO. McGeiver, a friend of Baker, publicly used the invention in Hawaii on April 15, 2000. The public use was not experimental and was without Baker's knowledge or consent. The public came into possession of the invention the day it was used by McGeiver.

(D) The patent application was filed on Monday, June 25, 2001, in the USPTO. The invention became known to the public in the United States in April 2000 as a result of disclosure on the Internet by Wilson, a party unknown to Able and Baker. The invention was not placed on sale or in public use prior to the filing date of the application.

(E) More than one year prior to the filing in the USPTO of a patent application on Monday, June 25, 2001, in the USPTO, the invention, a machine, was used secretly by John, another inventor, to make a product. The details of the invention are ascertainable by inspection or analysis of the product made by John that was sold and publicly displayed.

The model answer is selection (B).

38. ANSWER: The most correct answer is (B). 35 U.S.C. § 102(b). The on sale activity by the inventors was not a statutory bar since the one year anniversary ends on Tuesday, June 26, 2001. (A) is not the correct answer. 35 U.S.C. § 102(a). The reference, published before the filing date of the client's application, is prior art under 35 U.S.C. 102(a). The inventive entity is Able and Baker. The authorship is "by others," Able, Baker, and McGeiver. The reference is prior art "by others." See MPEP § 2132 ('Others' Means Any Combination Of Authors Or Inventors Different Than The Inventive Entity), and MPEP § 2132.01. See also *In re Katz*, 215 USPQ 14 (CCPA 1982). (C) is not correct. 35 U.S.C. § 102(b). The invention was placed in public use more than one year before the filing date of the patent application. See MPEP § 2133 (The 1 – Year Time Bar Is Measured From The U.S. Filing Date); MPEP § 2133.03(a); and *Egbert v. Lippmann*, 104 U.S. 333, 336

(1881). (D) is not correct. Although public knowledge may not be a public use or sale bar under 35 U.S.C. 102(b), it can provide grounds for rejection under 35 U.S.C. 102(a). MPEP §§ 2132 and 2133.03(a)(C) (Use by Independent Third Parties). In this instance, the public knowledge is more than one year before the application filing date. (E) is not correct. 35 U.S.C. § 102(b). A “secret” use by another inventor of a machine to make a product is “public” if the details of the machine are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings v. Ram Golf Corp.*, 188 USPQ 481, 483 - 484 (7th Cir. 1975); *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 310 (Fed. Cir. 1983).

Petitioner’s arguments have been fully considered but are not persuasive.

Petitioner has argued that “(B) is clearly not 102 prior art, but (E) may not be, and (A) almost certainly is not.” The best answer is answer (B), the answer petitioner concedes “is clearly not 102 prior art.” Regarding petitioner’s answer, answer (A), see MPEP § 2132. Paragraph III of that section provides a definition of what is meant by “Others” in 35 U.S.C. 102(a). “Others” refers to any entity which is different from the inventive entity in the application under examination. This holds true for all types of references eligible as prior art under 35 U.S.C. 102(a), including publications. Petitioner argues that “the authorship of the article is not relevant, rather it is the inventorship of the invention disclosed.” While it is true that all of the pertinent parts of the publication may be “attributed” to the inventors named in the application (Able and Baker) rather than to the other named author (McGeiver), the reference is nonetheless prior art under 35 U.S.C. 102(a). See MPEP § 716.10, Example 2. It would be necessary for the applicants to submit an affidavit under 37 CFR 1.132 to show that the relevant portions of the reference originated with or were obtained from applicant.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 43 reads as follows:

43. A claim in your client's patent application has been rejected as being anticipated by a prior art reference. In which of the following instances is the claim not necessarily anticipated?

- (A) The prior art is a U.S. patent issued five years before the effective date of your client's application. In your client's application, the claim is a generic claim. The prior art clearly discloses a species falling within the claimed genus in your client's application.
- (B) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 4 is directed to a species. The prior art discloses forty-six species. The species claimed in claim 4 is clearly disclosed by name in the prior art. The remaining forty-five species disclosed in the prior art do not anticipate or render obvious any subject matter claimed in your client's application.
- (C) The prior art is a U.S. patent issued two years before the effective date of your client's application. In your client's application, claim 1 is directed to "composition comprising copper oxygen, and 10 to 20 mg of sulfur." The prior art discloses a composition "comprising copper, oxygen and 15 mg. of sulfur."
- (D) The prior art is a U.S. patent issued two years before the effective date of your client's application. Claim 1 in your client's application is drawn to a composition of gases, and contains a narrow range of the amount of oxygen. The prior art discloses composition of the same gases, and a broad range of the amount of oxygen that is inclusive of the claimed narrow range, but does not disclose specific examples falling within the claimed narrow range. Your client not only discloses a different utility for the claimed invention, but also unexpected results achieved within the narrow range.
- (E) (A), (B), (C) and (D).

The model answer is selection (D).

43. ANSWER: The most correct answer is (D). MPEP § 2131.03 (Prior Art Which Teaches A Range Within, Overlapping, Or Touching The Claimed Range Anticipates If The Prior Art Range Discloses The Claimed Range With "Sufficient Specificity"). If the prior art discloses a range that touches, overlaps or is within the claimed range, but there is no disclosure of specific examples falling within the claimed, a case by case

determination must be made as to anticipation. To anticipate the claims, the claimed subject matter must be disclosed in the reference with “sufficient specificity to constitute an anticipation under the statute.” What constitutes a “sufficient specificity” is fact dependent. (A) is not correct. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Species Will Anticipate A Claim To A Genus) citing *In re Slayter*, 125 USPQ 345, 347 (CCPA 1960); and *In re Gosteli*, 10 USPQ2d 1614 (Fed. Cir. 1989). (B) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.02 (A Reference That Clearly Names The Claimed Species Anticipates The Claim No Matter How Many Other Species Are Named) citing *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). (C) is not the correct answer. 35 U.S.C. § 102(b); MPEP § 2131.03 (A Specific Example In The Prior Art Which Is Within A Claimed Range Anticipates The Range), and see *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)).

Petitioner’s arguments have been fully considered but are not persuasive.

Petitioner has argued that a claim to a “composition comprising copper oxygen, and 10 to 20 mg of sulfur” is not necessarily anticipated by prior art which discloses a composition “comprising copper, oxygen and 15 mg. of sulfur.” Petitioner has failed to point out the limitations required by “copper oxygen” that are not disclosed in the reference.

Additionally, the “DIRECTIONS” for the Afternoon Session included the following instruction: “Do not assume any additional facts not presented in the questions.”

Accordingly, it would be improper to assume that a definition of “copper oxygen” was provided in the specification which distinguishes “copper oxygen” from “copper, oxygen”.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor's patent that Acme fears might cover Acme's key commercial product. Acme informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor's December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent's validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme's costs. Which of the following is the most reasonable advice to Acme?

- (A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.
- (B) You suggest that Acme request *ex parte* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.
- (D) You suggest that Acme request *inter partes* reexamination on the basis of Acme's prior sales and the trade magazine publication.
- (E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

The model answer is selection (C).

48. ANSWER: (C). Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. *See, e.g.,* 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530, 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that none of the answers offered are appropriate, and that credit should be given for petitioner's answer (A). Answer (C) is the most correct answer because under the *inter partes* reexamination provisions, third party requesters have a greater opportunity to participate in the reexamination proceedings than they do under the *ex parte* reexamination provisions.

Petitioner argues that the question asks for legal advice which is beyond the purview of authority of a patent agent, and petitioner indicates that the PTO's caution to agents on practices is outlined in 37 CFR 10.14(d). The rule cited by petitioner relates to "trademark and other non-patent cases", not to patent cases. It indicates that recognition to practice before the Office in trademark and other non-patent cases "shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law." Question 48 requires some limited knowledge of the provisions (statutes and/or rules) relating to *ex parte* reexamination and *inter partes* reexamination. A practitioner conducting a comparison of the provisions relating to *ex parte* reexamination with the provisions relating to *inter partes* reexamination would not be engaged in the unauthorized practice of law.

Petitioner further argues that "the answer to this question is question is not in the MPEP or any other source a student is responsible to know." Page 2 of the examination booklet indicated, in part, "This examination also does address and test changes to the Patent Statute or regulations brought about by the enactment of the [American Inventors

Protection] Act.” The Act included a new Chapter 31 to Title 35 of the U.S. Code and conforming amendments providing for *inter partes* reexamination of patents that issued on original applications filed in the United States on or after November 29, 1999.

Among other provisions of the statutes so enacted, 35 U.S.C. 314(b)(3) provides an opportunity for a third-party requester to file written comments each time the patent owner files a response to an action on the merits from the Patent and Trademark Office, and 35 U.S.C. 315(b)(1) provides that a third-party requester may Appeal to the Board of Patent Appeals and Interferences under 35 U.S.C. 134. Because the advantages of filing an *inter partes* reexamination instead of an *ex parte* reexamination may be ascertained from the Patent Statutes, the answer to the question is included in a source a student is responsible to know.

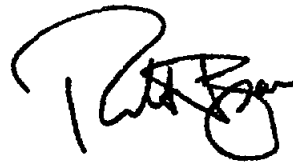
No error in grading has been shown. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, one additional point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy